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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of Campbell Rogers et al. :
Serial No.: 09/766,533 :
Filed: February 7, 2001 : PETITION DECISION
Attorney Docket No.: MIT 7501 CON :
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This is in response to applicants' petition, filed October 4, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(b) on February 7, 2001, claiming priority to application 08/823,999, filed March 25, 1997. The application, as filed, contained claims 1-17. On June 11, 2002, the examiner mailed a restriction requirement dividing the claims into 24 groups. In the response filed July 12, 2002, applicants elected Group I, drawn to methods of inhibiting stenosis or restenosis with Mac-1-specific antibodies. Applicants traversed the restriction requirement on essentially the same grounds as presented in the petition at hand. Applicants argued that the same set of claims was subject to an election of species requirement in the parent application, and that the method claims are linked by a common function.

On September 6, 2002 the examiner mailed a first Office action on the merits. The examiner pointed out that the claimed therapeutic agents are patentably distinct, in that there is no common structural feature and they each have a different mode of action. The examiner also noted that there is no requirement that the restriction requirement in a continuation application be identical to the requirement in the parent application. The restriction was made final.

DISCUSSION

Applicants present several lines of argument in the petition, including arguments based on the prosecution of the parent application. Consequently the prosecution history of the parent application has been reviewed. This review reveals that the original claims in the parent application are substantially identical to the amended claims present in the instant application. In the parent application, the claims were restricted into 2 groups (compositions and methods), with a further election of species required regardless of which group was elected. Each group was

divided into 24 species, for a total of 48 species. In the instant application, 12 compositions and 12 methods were identified as patentably distinct inventions. Some compositions named as species in the parent application were not named as inventions in the instant application, while some compositions named as inventions in the instant application were not named as species in the parent application.

Applicants argue that the claimed methods are all related to each other because they achieve the same result. This argument is not persuasive because the required search is based on the method steps to be performed, not the result to be obtained. Each therapeutic agent, or each therapeutic method utilizing a different therapeutic agent, requires a separate search of the prior art for the agent and/or its uses.

Applicants argue that an election of species requirement was made in the parent application, and that all of the species were searched. This argument is not persuasive. First, there is no requirement that the restriction requirement in a continuing application be identical to that imposed in the parent application. And as noted above, the lines of demarcation between species or inventions were drawn differently in the two applications. Moreover, there is no evidence that the examiner searched all of the species in the parent application.

Applicants argue that, in the parent application, prior art pertaining to the elected species was used to reject claims to non-elected species. Review of the prosecution history of the parent application does not support this allegation.

Applicants state, "These species are clearly related and do not constitute 24 separate patentably distinct inventions" (petition, p. 6). If applicants wish to stipulate that the different inventions are obvious variants, and prior art pertaining to one method may be used to reject the other methods, then the examiner should rejoin the method claims. However, applicants go on to state that an election of species is proper. Since the election of species requirement in the parent application stated that the species are patentably distinct, applicants appear to be agreeing that the claimed methods are patentably distinct. Absent an unambiguous statement that the 12 claimed methods are not patentably distinct, the examiner is justified in maintaining the restriction requirement.

Applicants argue that the generic claims are proper. This argument is not comprehended, since the examiner never stated otherwise.

Applicants argue that the same claims have already been prosecuted together. Review of the prosecution history of the parent application reveals this allegation to be untrue. No additional species were searched in the parent application, and the subject matter examined in the parent application has not been divided into more than one group in the instant application.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

The time period for filing a response to the outstanding Office action continues to run from the date of mailing, September 6, 2002.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

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